N. K. Fairbanks Co. v. Ogden Packing & Provision Co., 220 Fed. 1002, 1003 (D. Utah, 1914) 9

Graver v. Linde, 336 U. S. 271 12

S. C. Johnson & Son, Inc. v. Johnson, 121 U. S. P. Q. 63 (C. A. 6, 1959) 12

Keveskin v. Finkelstein, 223 F. 2d 677, 679 (C. A. 7, 1951) 15

Miles Laboratories, Inc. v. Pepsodent Co., 104 F. 2d 205, 207 (C. C. P. A., 1939) 8

Nestle's Milk Products, Inc. v. Baker Importing Co., 182 F. 2d 193, 196 (C. C. P. A., 1950) 9

Perfectform Corp. v. The Perfect Brassiere Co., 256 F. 2d 736 (C. A. 3, 1958) 9

The Quaker Oats Co. v. St. Joe Processing Co., 232 F. 2d 653, 656 (C. C. P. A., 1956) 9

Schering & Glatz, Inc. v. Sharp & Dohme, Inc., 146 F. 2d 1019, 1021 (C. C. P. A., 1944) 9

G. D. Searle & Co. v. Chas. Pfizer & Co., 231 F. 2d 316 (C. A. 7, 1956) 13

G. D. Searle & Co. v. Chas. Pfizer & Co., Inc., 105 U. S. P. Q. 391 (1955) 6

Syncromatic Corp. v. Eureka Williams Corp., 174 F. 2d 649, 650 (C. A. 7, 1949) 8

Younghusband v. Kurlash Co., 94 F. 2d 230, 231 (C. C. P. A., 1938) 8

Statutes and Rules.

Rule 52(a), F. R. C. P. 12

Trademark Act of 1946, 15 U. S. C. et seq. 13, 14

28 U. S. C. § 2106 15

IN THE

Supreme Court of the United States

OCTOBER TERM, 1959.

No. 142.

CHAS. PFIZER & CO., INC.,

Petitioner,

vs.

G. D. SEARLE & CO.,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

BRIEF FOR RESPONDENT IN OPPOSITION.

STATEMENT OF THE CASE.

This is an ordinary trademark case. Its only unusual feature is the overwhelming quantity of uncontroverted evidence of infringement.

The facts of this case are simple:

In 1947, respondent, G. D. Searle & Co., developed a pharmaceutical product for which it adopted the descriptive name dimenhydrinate and the fanciful and coined trademark DRAMAMINE (J.A. 1278; App. B to Petition for Certiorari, 13a). After clinical testing by doctors at Johns Hopkins and the Surgeon General of the Army

which established its effectiveness, DRAMAMINE was released for prescription sale as a motion sickness remedy on March 3, 1949 (J.A. 33-34, 55-56, 901, 981-982, 1278; App. B, 13a).

DRAMAMINE was widely recognized as the first effective motion sickness remedy (J.A. 38, 911-917, 923-927). Prior to December 1, 1953, its sales had exceeded $12,000,000 (App. B, 13a). On November 10, 1954, DRAMAMINE was released for sale to the general public without prescription (J.A. 1040-1046, 1279; App. B, 13a).

Respondent's motion sickness remedy has been sold under the trademark DRAMAMINE since it was placed on the market (J.A. 1278; App. B, 13a). The trademark DRAMAMINE was registered in the United States Patent Office, and the registration has become incontestable (J.A. 979, 1255-58; App. B, 13a).

On or about July 1, 1953, petitioner, Chas. Pfizer & Co., purchased the United States rights to a product, U. C. B. 5062, which had been developed by a Belgian manufacturer and sold in Europe as a motion sickness remedy under the trademark "Postafene" (J.A. 118-119, 126-127, 1193-1194; App. B, 13a).

On or about June 29, 1953, petitioner requested certain of its employees to suggest a trademark for U. C. B. 5062, informing them that the product was "to be indicated for use in motion sickness and is competitive with Dramamine" (J.A. 983-985, 1057-1058; App. B, 13a). The name BONAMINE was selected from 158 names suggested by employees (J.A. 993-994, 996-997, 1001-1002).

In August, 1953, petitioner published the name BONAMINE in the Bulletin of the Combined Trademark Bureau of the American Drug Manufacturers Association and the American Pharmaceutical Manufacturers Association as a proposed trademark for an antihistamine, and *not* as a motion

sickness remedy, although the rules governing such publication required a statement of the *therapeutic* use of the product to which the name was to be applied (J.A. 1003, 1240; App. B, 19a).

Petitioner's product was released for prescription sale as a motion sickness remedy under the name BONAMINE on or about December 1, 1953 (J.A. 1278). Not until then did respondent discover that petitioner intended to use BONAMINE as a motion sickness remedy rather than an antihistamine (J.A. 74-77; App. B, 19a). Respondent promptly protested this use of the name BONAMINE, and on December 16, 1953, instituted this action for trademark infringement and unfair competition (J.A. 1, 1058-1059; App. B, 19a).

On November 29, 1955, BONAMINE was released for sale to the public without prescription (J.A. 1279).

The trial in this case occupied four and one-half days in May and June, 1957. At the trial, the uncontroverted evidence demonstrated that the products designated as DRAMAMINE and BONAMINE are sold for identical uses, are sold through the same channels of trade, are sold to the same class of customers, are sold without consumer advertising, are promoted by word-of-mouth advertising, are often purchased by oral or telephone requests, and are priced competitively (App. B, 17a*).

Respondent presented extensive testimony from members of the public establishing that the trademarks DRAMAMINE and BONAMINE are confusingly similar both in sound and appearance (J.A. 256, 265, 272, 282, 291, 297, 310, 321, 635, 1097-1192). Respondent presented evidence that petitioner's use of the name BONAMINE had resulted in actual confusion of the public between DRAMAMINE and BONAMINE

* J.A. 38, 101-102, 461, 1277-78; 27-30, 32, 38, 45-46, 210, 238-239, 394-397, 438, 458-459, 472; 30-32, 45-46, 438-439; 211-212, 239-240, 547-548, 1049, 1052-1057; 256-257, 265-266, 282-283, 291-292, 298-299, 310-311, 369-370; 247-248, 370; 1274.

as to the source of the goods sold under these trademarks (J.A. 40-43, 371-373, 399-403, 1065, 1144-1145; App. B, 16a). Respondent presented evidence that the similarity between the names DRAMAMINE and BONAMINE had resulted in the palming off of petitioner's product for that of the respondent (J.A. 343-344, 381-388; App. B, 19a).

Petitioner's only answer to this evidence was to attempt to attack the method employed by respondent in identifying some of the witnesses whose testimony was offered, and to criticize respondent for not calling to the stand every person ever interviewed as a prospective witness.

Respondent also presented the testimony of an expert witness who testified to the phonetic similarities between DRAMAMINE and BONAMINE. He made a phonetic comparison of the other 157 names considered by petitioner, finding BONAMINE the most similar to DRAMAMINE (J.A. 149, *et seq.*). Petitioner, of course, countered with its own expert who found only 17 other words on the list of 158 (including such words as "Transidene" and "Travelazine") to be more similar to DRAMAMINE than is BONAMINE (J.A. 489-581, particularly at 496-497). The two experts agreed that there were five points of similarity between the sounds DRAMAMINE and BONAMINE, however the words were pronounced:

1. DRAMAMINE and BONAMINE contain the same number of syllables.

2. DRAMAMINE and BONAMINE have the same stress pattern—primary accent on the first syllable and secondary accent on the third.

3. The last two syllables of DRAMAMINE and BONAMINE are identical.

4. The initial sounds of DRAMAMINE and BONAMINE ("d" and "b") are both what are known as "voiced plosives" and are acoustically similar.

5. The consonants "m" and "n" are nasal sounds which are acoustically similar (J.A. 156-158; 493, 515, 521; App. B, 15a).

The petitioner's expert witness further admitted that if the initial vowel sound in DRAMAMINE were pronounced "ah," DRAMAMINE and BONAMINE were rhyming words, and hence "confusable" words (J.A. 156-158; 515, 520). Although the experts disagreed as to whether or not the majority of the public would be more likely to pronounce the firsf syllable of DRAMAMINE with a broad or a short "a," other evidence clearly established that a substantial number of people actually pronounce it each way (J.A. 248, 370-371).

Respondent offered further evidence which clearly established that petitioner acquired the rights to the product it sold as BONAMINE for the purpose of entering the extensive market for motion sickness remedies which had been established by DRAMAMINE; that the dominant consideration in the selection of the name BONAMINE was the fact that the product was to be sold in competition with DRAMAMINE; that petitioner gave notice of its intention to use the name BONAMINE in a manner calculated to conceal its intention to use it for a motion sickness remedy; and that petitioner admittedly had no policy of seeking to adopt distinctive trademarks.*

Petitioner's principal defense rested in an attempt to persuade the courts to ignore the trademarks in suit, DRAMAMINE and BONAMINE, in their entireties, and to consider only their separate parts. It argued that the trial court should ignore the identical suffix "amine" and compare only the prefixes "dram" and "bon". It alleged that "amine" was descriptive of the products. This precise defense had previously been stricken in a Patent Office

* J.A. 100, 532, 1023; 38, 58, 63-64, 246; 1025; 984-985; 1003, 130, 460-463; 222.

proceeding instituted by respondent to prevent registration of BONAMINE. *G. D. Searle & Co.* v. *Chas. Pfizer & Co., Inc.*, 105 U. S. P. Q. 391 (1955).

Eight months after the trial ended, the District Court entered the findings and conclusions set forth at pages 9a through 11a of Appendix B to the petition. Respondent promptly appealed, on the ground that the findings of fact were inadequate to support the conclusion that petitioner had not infringed respondent's trademark in that

(1) the only finding relative to the trial court's conclusion (Finding No. 10) was conclusory and unsupported by the subsidiary findings,

(2) the finding was based on an erroneous theory of law, and

(3) the trial court had failed to make any findings with respect to the material issues of likelihood of confusion, actual confusion and palming-off, and intent.

Respondent further urged the Court of Appeals to enter judgment on the basis of the record below in view of the length of time the case had been pending and the fact that the evidence introduced was preponderantly documentary or by deposition, and consisted in large part of answers to interrogatories or admissions of fact.

As shown by its opinion, the Court of Appeals agreed that Finding 10 was the only finding relating to the issues in the case, and that the finding was, in part, based on an erroneous theory of law (App. B, 15a). It did not pass upon respondent's contention that the part of the trial court's finding which stated simply the trial court's conclusion that "The words 'DRAMAMINE and BONAMINE' are unlike" was conclusory. Instead, the Court of Appeals held the finding to be clearly erroneous. In reaching this conclusion, the Court relied only upon the undisputed evidence of record (App. B, 15a; pp. 4-5, *supra*).

Petitioner urged in the Court of Appeals, and urges now, that the trial court's ninth, fourteenth and fifteenth findings supported Finding 10 and the trial court's conclusion (Pet., pp. 2, 6-8).

The ninth finding (App. B, 10a) consisted of four sentences, all more or less true, but all meaningless in this case:

1. "The products [sold as DRAMAMINE and BONAMINE] are both members of the large and well-known chemical class of organic amines."

Even ignoring the fact that the product sold as DRAMAMINE is not itself an organic amine (J.A. 848), the only evidence of record indicated that the terms "amine" and "organic amine" had no meaning to the public (J.A. 258, 282, 284, 530-531; and see *American Home Products Corp.* v. *Willard*, 114 U. S. P. Q. 353, 354 (1957).

2. "The record shows that numerous products which have been sold in drugstores for years contain the amine suffix."

The record did disclose that some 66 products, ranging from antihistamines through vitamins, headache remedies, products for treating obesity, diuretics and urinary antiseptics, and even a deodorant, had been sold under names ending in "amine" (J.A. 666-669). If anything, this evidence demonstrated that only the rashest purchaser would rely on the suffix "amine" as describing the "chemical and physiological properties" of a product to which it was applied.

3. "Some of these [66] products are antihistamines and some of them are motion sickness remedies."

Ten of the 66 were antihistamines, and three, which were *not* antihistamines, were recommended for motion sickness (compare J.A. 1067-1096 with J.A. 666-669). In fact, of the forty-three motion sickness remedies and the

110 antihistamines on the market in 1954, only five motion sickness remedies and six antihistamines had names ending in either "amine" or "amin" (J.A. 1075, 1085).

4. "Some antihistamines are useful as motion sickness remedies."

But as petitioner's exhibits demonstrated, most antihistamines are not, and "no correlation appears to exist between antihistamine potency and motion sickness protection" (J.A. 784-785, 838). Furthermore, only six products are recommended both as antihistamines and as motion sickness remedies (J.A. 1075, 1085). Neither DRAMAMINE nor BONAMINE has ever been recommended as an antihistamine although both, technically, fall in that category (J.A. 1271-1272; 128-129, 460-463, 983-985).

The half-truths of Finding No. 9, viewed against the record, do not support petitioner's contention that the suffix "amine" is either "a well-known technical term" or that it is descriptive of the "chemical and physiological nature" of the products sold as DRAMAMINE and BONAMINE, or that it is commonly employed for motion sickness remedies (Pet., p. 6).

In any event, even if petitioner's contention were well-founded, they would be relevant only if its claims that the court should consider the trademarks bit by bit rather than as a whole and that common elements of trademarks can be disregarded in determining likelihood of confusion were legally valid. If there is one aspect of trademark law which is established beyond question, it is that likelihood of confusion must be determined by comparing the similarities between the trademarks in their entirety, and can never be disproven by disregarding common elements. *Younghusband* v. *Kurlash Co.*, 94 F. 2d 230, 231 (C. C. P. A., 1938); *Miles Laboratories, Inc.* v. *Pepsodent Co.*, 104 F. 2d 205, 207 (C. C. P. A., 1939); *Syncromatic Corp.* v. *Eureka Williams Corp.*, 174 F. 2d 649, 650

(C. A. 7, 1949); *Nestle's Milk Products, Inc.* v. *Baker Importing Co.*, 182 F. 2d 193, 196 (C. C. P. A., 1950); *Schering & Glatz, Inc.* v. *Sharp & Dohme, Inc.*, 146 F. 2d 1019, 1021 (C. C. P. A., 1944); *The Quaker Oats Co.* v. *St. Joe Processing Co.*, 232 F. 2d 653, 656 (C. C. P. A., 1956); *Perfectform Corp.* v. *Perfect Brassiere Co.*, 256 F. 2d 736 (C. A. 3, 1958); *Dietene Company* v. *Dietrim Company*, 225 F. 2d 239, 243 (C. A. 8, 1955); *N. K. Fairbanks Co.* v. *Ogden Packing & Provision Co.*, 220 Fed. 1002, 1003 (D. Utah, 1914).

The fourteenth finding states merely:

> "Although neither of the tablets is particularly distinctive in appearance, they do differ in color and size. The packaging also differs. It is plaintiff's [respondent's] contention that a confusing similarity exists not in physical appearance or dress but between the spoken sound and the appearance in print of the coined words constituting the two trademarks" (App. B, 11a).

If this finding was intended as anything more than a restatement of respondent's claim, the evidence relating to the manner of marketing and promoting these products reviewed above clearly demonstrated that differences in the appearance and packaging of the products is of little or no assistance to the public in distinguishing between them (see p. 3, *supra*; App. B, 17a).

The fifteenth finding, that "users of medicine generally exercise a high degree of care" and that "medicines * * * are purchased with great care," is wholly unsupported by any evidence and offends common sense.

The only "evidence" on this subject consisted of the statement of the sales manager of respondent that he was not qualified to testify whether or not the consumers purchasing motion sickness remedies were "intelligent and discriminating" (J.A. 356-358), and the statement of an

officer of petitioner that the "adult portions of the American population certainly are discriminating and intelligent" (J.A. 443-444).

While users of some medicines are, of course, cautious, there is no evidence that purchasers of motion sickness remedies sold over the counter would exercise "great care" to get DRAMAMINE rather than BONAMINE, or vice versa. Both are used and are effective for identically the same purpose, and both are produced by well-known pharmaceutical manufacturers and sold to the general public without prescription.

The Court of Appeals having found the only material finding made by the trial court to be clearly erroneous did review the record below and concluded that "the evidence in this case compels a holding that the trademark "Bonamine" is likely to cause confusion and mistake among purchasers of drugs who seek relief from motion sickness" (App. B, 18a). It directed the District Court to enter an injunction restraining the use of the trademark BONAMINE for motion sickness remedies.

ARGUMENT.

I. THE "QUESTIONS PRESENTED" STATED BY PETITIONER ARE NOT PRESENTED IN THIS CASE.

Whatever interest this Court might have in the questions stated by the petitioner (Pet., p. 4), those questions are not presented by this case.

As shown by the foregoing statement of the case, the three questions stated by petitioner should be restated as follows:

1. In a case where one trademark is alleged to be confusingly similar to another because of their acoustic similarity, is an appellate court justified in setting aside, as clearly erroneous, a bare finding that the trademarks are "unlike" where the undisputed evidence establishes at least five material points of similarity between the sounds of the two trademarks, however pronounced?

2. In determining whether or not the concurrent use of two trademarks in the sale of substantially identical products is likely to result in confusion, may a trial judge rely solely upon his personal impression of the acoustic similarity of the trademarks as pronounced by counsel and witnesses in the courtroom, and wholly ignore undisputed evidence that

   a. as established by petitioner's and respondent's experts, the trademarks have at least five material points of acoustic similarity;

   b. the products were marketed and promoted through the same channels of trade and by the same media;

   c. the concurrent use of the two trademarks had resulted in actual confusion;

d. the concurrent use of the two trademarks had resulted in the palming-off of petitioner's product for that of respondent; and

e. petitioner had deliberately adopted its trademark with the intent of trading upon the goodwill attaching to respondent's trademark?

3. Where, in a trademark case, the appellate court determines that the only finding made by the trial court as to likelihood of confusion is, in part, clearly erroneous, and, as to the balance, based upon an erroneous theory of law, must the appellate court remand the case to the trial court, where the evidence of record is composed in large part of documents, depositions, answers to interrogatories or admissions, the relevant oral testimony is undisputed, and the record as a whole "compels" the conclusion that one party is entitled to judgment?

The answers to these questions are clear, and present no occasion for review by this Court.

II. THERE IS NO CONFLICT BETWEEN THE INSTANT DECISION AND ANY DECISION OF THIS OR ANY OTHER COURT INTERPRETING RULE 52(a).

The cases relied upon by petitioner [*Graver* v. *Linde*, 336 U. S. 271; *Benrose Fabrics Corp.* v. *Rosenstein*, 183 F. 2d 355 (C. A. 7, 1950); *S. C. Johnson & Son, Inc.* v. *Johnson*, 121 U. S. P. Q. 63 (C. A. 6, 1959)] merely establish the undisputed rule that an appellate court may not set aside a finding of the trial court unless the finding is clearly erroneous. Rule 52(a), F. R. C. P.

In the present case, the Court of Appeals adhered to that rule. It set aside only one finding of the trial court; it fould that finding to be clearly erroneous since it conflicted squarely with the undisputed evidence of record (App. B, 15a). There was no substantial evidence to support the finding.

There is no legal issue to be resolved, and no conflict of decision.

III. THERE IS NO CONFLICT BETWEEN THE INSTANT DECISION AND OTHER TRADEMARK DECISIONS.

Likelihood of confusion is a question of fact. *G. D. Searle & Co.* v. *Chas. Pfizer & Co.*, 231 F. 2d 316 (C. A. 7, 1956) (App. B, 7a). The fact that one court determines that two trademarks are not confusingly similar and another court finds that two entirely different trademarks are confusingly similar, does not mean the decisions are in conflict.

As the Court of Appeals sensibly stated in this case:

> "In this type of litigation reference to decisions of courts as to other trademarks is not of great help. Citation of individual cases can only indicate a general pattern. Often the background of the adoption of the mark is of importance on the question of intent. The evidence as to actual confusion or likelihood of confusion differs widely from case to case." (App. B, 18a.)

Nor does the fact that courts find some trademarks confusingly similar and others not confusingly similar evidence any uncertainty in the lower courts concerning the resolution of questions of likelihood of confusion. The lower courts have no difficulty resolving each case on its own facts.

IV. THIS PETITION PRESENTS NO QUESTIONS OF PUBLIC IMPORTANCE RELATING TO THE CONSTRUCTION OF THE TRADEMARK ACT OF 1946.

Petitioner asserts that the Trademark Act of 1946 fails to establish standards for determining when a mark is likely to cause confusion and mistake. These standards were well established when the Act was adopted.

The clearest of these standards is simply stated:

> The test of likelihood of confusion is whether or not the public is likely to be confused by the trademarks singly presented, and not whether the court can, upon comparison, distinguish between them. *Albert Dickinson Co. v. Milos Peanut Co. of Illinois*, 179 F. 2d 265, 270 (C. A. 7, 1950); *Colburn v. Puritan Mills, Inc.*, 108 F. 2d 377, 378 (C. A. 7, 1939).

In the present case, the trial court based its decision that the trademarks in suit were not acoustically similar on its "close attention" to the pronunciation given to the words by counsel and witnesses, and not on the evidence (J.A. 1278, App. B, 10a). In effect, the trial court said, "I've listened carefully to these two words, pronounced one after the other by the lawyers and the witnesses, and they didn't sound alike to me personally." As the Court of Appeals held, this type of comparison is no different from the side-by-side visual comparison condemned by the courts (App. B, 16a-17a).

The application of this conventional test in this case certainly creates no uncertainty as to the interpretation of the Trademark Act and requires no action by this Court.

V. THE COURT OF APPEALS ACTED PROPERLY IN DIRECTING THE ENTRY OF JUDGMENT FOR THE RESPONDENT.

Petitioner has confused what respondent asked the Court of Appeals to do with what the Court actually did. Petitioner characterizes the Court of Appeals' decision as a determination that the findings made were inadequate. What the Court of Appeals actually held was that the only relevant finding was clearly erroneous. It expressed no opinion as to its adequacy if it had been supported by any substantial evidence.

Of course, whether the trial court's findings are viewed as clearly erroneous or as inadequate, the reviewing court is not required to remand the case for further findings if it can determine from the record before it that one party or the other is clearly entitled to judgment. *Kweskin* v. *Finkelstein*, 223 F. 2d 677, 679 (C. A. 7, 1951); 28 U. S. C. § 2106.

In this case, the bulk of the record consisted of admissions of fact, answers to interrogatories, depositions, and documents. The oral evidence was largely undisputed; the only possible conflict was between opinions of expert witnesses, who actually agreed on the material points of fact. The Court of Appeals was not required to set aside any findings of the trial court except the single finding which was clearly erroneous.

The Court of Appeals found that the record before it *compelled* a holding in favor of respondent (App. B, 18a). A review of the court's opinion confirms this conclusion.

It is no wonder that petitioner seeks a new trial. (Respondent cannot conceive that petitioner seriously contends that the trial court's judgment should be reinstated.) Petitioner, by virtue of an erroneous summary judgment, an untenable trial court decision, and the filing of this petition, has been enabled to enjoy the fruits of its deliberate infringement of respondent's trademark for almost six years. A new trial will permit it to continue to trade upon respondent's goodwill for a further period. Since the Court of Appeals restricted respondent to injunctive relief, respondent will never be made whole.

A new trial would be a futile gesture in this case. Petitioner had four years to get ready for the first trial, and failed to present any substantial evidence. On any record like that now before the Court, the conclusion reached by the Court of Appeals is the only conclusion possible.

CONCLUSION.

This litigation is of importance only to the litigants; it is not of such gravity and general importance as to justify a review by this Court.

The petition for a writ of certiorari should be denied.

Respectfully submitted,

STUART S. BALL,
RICHARD J. FLYNN,
11 South La Salle Street,
Chicago 3, Illinois,
Attorneys for Respondent.

Of Counsel:
WM. T. WOODSON,
LEWIS S. GARNER,
WALTER RAMM,
SIDLEY, AUSTIN, BURGESS & SMITH,
WOODSON, PATTISHALL & GARNER.

CERTIFICATE OF SERVICE.

I, Stuart S. Ball, one of the attorneys for G. D. Searle & Co., respondent herein, and a member of the Bar of the Supreme Court of the United States, hereby certify that on the 21st day of August, 1959, I served the foregoing brief in opposition on the petitioner by mailing copies in duly addressed envelope, with first class postage prepaid, to its attorney of record.

.....

STUART S. BALL,
11 South La Salle Street,
Chicago 3, Illinois,
Attorney for Respondent.

LE COPY

Office-Supreme Court, U.S.
FILED
SEP 15 1959
JAMES R. BROWNING, Clerk

IN THE

Supreme Court of the United States

October Term, 1959.

No. 142.

CHAS. PFIZER & CO., INC.,

Petitioner,

v.

G. D. SEARLE & CO.,

Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Seventh Circuit.

PETITIONER'S REPLY BRIEF.

ARTHUR G. CONNOLLY,
Beneficial Building,
Wilmington 99, Delaware,
Attorney for Petitioner.

WERNER H. HUTZ,
THOMAS J. CONNORS,
WILLIAM J. MARSHALL, JR.,
Of Counsel for Petitioner.

September 15, 1959.

International, 711 So. 50th St., Phila. 43, Pa.

IN THE

Supreme Court of the United States.

OCTOBER TERM, 1959.

No. 142.

CHAS. PFIZER & CO., INC.,

Petitioner,

v.

G. D. SEARLE & CO.,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

PETITIONER'S REPLY BRIEF.

Respondent's brief largely ignores the essential facts of record in this case which led the trial judge to find as a fact that the trademarks in issue "are unlike". This finding completely disposed of the ultimate factual issue involved in the case—whether the products of the parties are likely to be confused because petitioner's trademark is a colorable imitation of respondent's. The subsidiary finding that the trademarks are not "acoustically similar" disposed of the specific contention upon which respondent had relied in the trial court.

These findings were swept aside by the court of appeals; the first because it was categorized as "clearly

erroneous", and the second because the court of appeals ruled the trial judge could not determine acoustic dissimilarity from the testimony adduced during the trial. After thus disposing of these findings, the court of appeals then proceeded to arrive at contrary findings from the same record.

The pertinent findings of the trial judge and the evidence which supports them are set forth in our petition (pp. 6-10). Whether, as respondent attempts to show, there was some evidence to support the findings of fact by the court of appeals, reversing those of the trial judge, is immaterial.

The basic questions raised by the record in this case, as pointed out in our petition (p. 4) are:

1. Was the finding by the trial judge that the trademarks in issue are "unlike" one another clearly erroneous?

Both the court of appeals and respondent have ignored the substantial oral and documentary evidence which supports this finding, thereby permitting themselves to do violence to F. R. C. P. 52(a), as construed by this Court in *Linde v. Graver*, 336 U. S. 271, and by the courts of appeal of other circuits in more recent decisions (petition, pp. 11-13).

2. Is the ruling of the court of appeals correct, that the trial judge, in determining whether two trademarks are acoustically similar, cannot observe the manner in which they are pronounced by counsel and witnesses throughout the trial?

The test of acoustic similarity is dispositive of many trademark infringement and unfair competition cases, but the amazing decision of the court of appeals required the trial judge to close his ears to the best evidence upon which this issue can be adjudicated (petition, pp. 15-16).

3. If the findings of fact by the trial judge are held to be insufficient by the court of appeals, may it then resolve sharp conflicts in the evidence and make its own findings of fact, or should it remand the case to the district court for supplemental findings or a new trial?

Only the trial judge has the opportunity to observe the demeanor of the witnesses and to judge of their credibility, so conflicts in their testimony on basic issues should be disposed of by him rather than the appellate court (petition, pp. 14-15).

In addition to ignoring the essential facts of record on which the trial judge's findings are based, and referring to conflicting evidence as "undisputed", respondent's brief places great stress upon an unfairly slanted version of its so-called evidence of confusion.

Respondent's brief refers (p. 3) to what it calls "extensive testimony from members of the public establishing that the trademarks DRAMAMINE and BONAMINE are confusingly similar in both sound and appearance". A short discussion of this testimony is in order because it illuminates an insidious technique which permits a wealthy trademark owner to take unfair advantage of a defendant in this type of litigation.

Respondent produced its "evidence" as to the likelihood of consumer confusion by means of an elaborate special survey conducted by professional investigators working under close supervision of respondent's attorneys and paid by respondent. The survey extended over a period of more than two years and involved subjecting approximately 7,000 individuals throughout the country to "sidewalk interviews" (J. A. 423-5, 683-705). The investigators asked questions from forms of questionnaire which violated basic rules for conducting interviews by using the very names which the persons interviewed were supposed to volunteer without prompting (J. A. 492) and by employing

grossly leading questions to suggest there had been confusion between the names (J. A. 665). Eight different forms of questionnaire were used (J. A. 658-65) while respondent was, in the language of its chief investigator, "experimenting trying to find a questionnaire that would serve the purpose" (J. A. 691).

Despite the unfair manner in which the survey was conducted, virtually no one interviewed had any difficulty in distinguishing between the names BONAMINE and DRAMAMINE. Respondent took the depositions of about twenty persons who had been interviewed, whom respondent's chief investigator stated were his "best prospects" (J. A. 703-4). Of these, five turned out to be so unfavorable to respondent that respondent did not want them in evidence and they had to be offered by petitioner. The remainder showed either no confusion whatever or a borderline form of confusion which was attributable to the manner in which the survey was conducted rather than to any similarity between the names (J. A. 564-657, 1097-1192).

One of the "best prospects" was a Miss O'Connor, who testified she had never bought or used any motion sickness remedies, but that she had heard of DRAMAMINE. When asked whether she was familiar with BONAMINE she answered "No", thereby demonstrating her own lack of confusion in distinguishing between the two names (J. A. 576). Notwithstanding this, respondent's chief investigator, Mr. Christophersen, gave her two briefings in the period following her interview and before she gave her deposition, during which he "explained" to her why she nevertheless was confused (J. A. 581-3).

Two others of the "best prospects" were a Mr. Rauch and a Mr. Ackles, who each testified that the interviewers mispronounced the name BONAMINE as though it were spelled B-R-A-M-A-M-I-N-E or B-R-O-N-A-M-I-N-E (J. A. 505-6, 1123-4, 1127).

The witness on whom respondent relied primarily was a Mrs. Lort, who had been purchasing DRAMAMINE for six or

seven years. She testified that on one occasion she had sought to purchase DRAMAMINE for her children in a drug store but instead received BONAMINE (J. A. 383-7), but her testimony was contradicted in many material respects by her husband (J. A. 588-99). Since Mrs. Lort testified in person at the trial, her credibility could best be judged by the trial judge.

Other testimony of this character presented by respondent came from respondent's own officers who testified in person as to supposed instances related to them by friends and relatives or overheard at a busy airport (J. A. 39-43, 94-5, 344, 401-3). Being hearsay, this was entitled to little or no weight. None of these supposedly confused persons were produced.

Respondent's other main attack is to criticize petitioner (brief, pp. 2-3) for having published the name BONAMINE in the bulletin of the combined Trademark Bureau of the American Drug Manufacturers Association and American Pharmaceutical Manufacturers Association as a proposed trademark for an antihistamine, and not as a motion sickness remedy. This criticism is unjustifiable, not only because respondent admits (brief, p. 8) that antihistamines are frequently used for motion sickness and, as the district court found, both DRAMAMINE and BONAMINE are antihistamines (App. B. 10a, Finding No. 9), but also because when respondent itself published its name DRAMAMINE in the same publication it too described the product to which it was to be applied as an antihistamine and made no reference to its therapeutic usefulness as a motion sickness remedy (J. A. 893). Indeed, respondent *expressly* refused to state any therapeutic use (J. A. 892).

Before concluding, we call the Court's attention to the fact that a petition for a writ of certiorari (No. 147, October Term, 1959) has been filed in *S. C. Johnson & Son, Inc. v. Johnson*, 121 USPQ 53 (CA 6, March 30, 1959), one of the cases cited in our petition (pp. 12-13) as being in conflict with the decision of the court of appeals in the instant case.

We respectfully submit that respondent's brief in opposition actually demonstrates that this case is one of those which ought to be reviewed by this Court in the exercise of its discretionary jurisdiction. We believe no better opportunity can be found for resolving the important questions presented which have been most troublesome to the public and to the lower courts generally.

ARTHUR G. CONNOLLY,
Beneficial Building,
Wilmington 99, Delaware,
Attorney for Petitioner.

WERNER H. HUTZ,
THOMAS J. CONNORS,
WILLIAM J. MARSHALL, JR.,
Of Counsel for Petitioner.

September 15, 1959.